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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,512	06/01/1999	BRAD KINDIG	ISAA0037	9272
22862	7590	12/13/2006	EXAMINER COLBERT, ELLA	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			ART UNIT 3694	PAPER NUMBER

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/323,512	Applicant(s) KINDIG ET AL.	
	Examiner Ella Colbert	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-12,14-19,30 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-12, 14-19, 30, and 32-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3-8, 10-12, 14-19, 30, and 32-35 are pending. Claims 1, 8, 11, 12, 16, 18, 30, 32, 34, and 35 have been amended in this communication filed 09/14/06 entered as Response After Non-Final Action.

Claim Objections

2. Claims 1, 8, and 12 are objected to because of the following informalities: Claim 1, lines 10-18 and lines 23-29 recite “responsive to said receiving ...; ...; responsive to said ..., ...; if said new data record ...; ...; otherwise, ranking ...; ...; if said sum ...; and if said sum ...”. These steps are in improper method claim format. The steps in claim 1 in order to be in proper method claim format should recite as follows: “identifying one of the sections based upon the associated key of the new data record in response to said receiving said new data record and said associated key; identifying one of the sections in response to determining said ...; storing said new data record in identified section if said new data record fits in unused storage space and ending the process; ranking all data records in said section ...; ...; ending the process by returning a failure indicator, indicating ... if the sum is not greater than said size of the new data record; and deleting one or more data records from the identified section ... at the end of the identified section if said sum is greater than said size of said new data record”. Claims 8 and 12 have a similar problem. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8, 12, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Claim 1, beginning at line 12 should recite "identifying one of the sections based upon the associated key of the new data record, determining if ...; storing said new data record if based on the size if new data record fits in said unused storage space in said identified section and ending the process; ranking all data records in said identified section according to a computer implemented ranking function if said new data record does not fit in said unused storage space; ...; ending the process ... in the identified section if said sum is not greater ...; and deleting one or more data records ... the end of the identified section if the sum is greater than ...". Claims 12, and 30 have a similar problem.

Claims 5-6 recite the elements of a system or apparatus claim and the preamble recites a computer implemented method. Thus the claims cross two separate statutory classes of invention. Furthermore, "computer-implemented" can be deleted from the preambles of claims 3-7 in view of the recent *In re Lundgren* decision. The preamble of claims 3-7 should recite "the method of claim 1".

For example claim 5 would be better recited as "The method of claim 1, wherein each of ... used to transfer data between a primary storage ...". Claim 6 can be written similar to claim 5. Claim 7 can recite "The method of claim 1, allocating a contiguous

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memory space to contain each of the sections, wherein each of the sections is about the same page size.

Claims 3-7, 10, 11, 14-19, and 32-35 are also rejected because they depend from a rejected base claim.

Conclusion

5. The application will be in condition for allowance once the claim objections and the 35 USC 112 second paragraph rejections have been resolved if there not any other outstanding claim issues and an updated search does not produce any prior art to reject the claims.

Inquiries


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 7, 2006



ELLA COLBERT
PRIMARY EXAMINER